

INTERFERENCE INITIAL MEMORANDUM

Count # 1

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases: **104677**This interference involves 2 parties

| | | | | |
|---|-------------------------|----------------------------|-------------------------------|-------------------------------|
| PARTY MULHAUSER ET AL | SERIAL NO. 08/250657 | FILING DATE 5/27/94 | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
| If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>Maintenance fees not due yet</u> | | | | |
| **Accorded the benefit of: | | | | |
| COUNTRY | SERIAL NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
| U.S. | 07/886689 | 5/20/92 | | |
| The claim(s) of this party which correspond(s) to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 48,59-62 (allowable) | | | | |
| The claim(s) of this party which does(do) not correspond to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 49-58,63,64, 73-76 | | | | |
| PARTY GREEN ET AL | SERIAL NO. 07/906588 | FILING DATE 6/30/92 | PATENT NO., IF ANY 5304187 | ISSUE DATE, IF ANY 4/19/94 |
| If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>x</u> Maintenance fees not due yet | | | | |
| **Accorded the benefit of: | | | | |
| COUNTRY | SERIAL NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
| | | | | |
| The claim(s) of this party which correspond(s) to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 1 | | | | |
| The claim(s) of this party which does(do) not correspond to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 2-38 | | | | |

Instructions

1. For every patent involved in the interference, check if the fees have been paid by using the patent number with the PALM screen CR06.

If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent. (35 USC 135(a); 37 CFR 1.606).

2. For each party, separately identify the patentable and unpatentable claims which correspond to the count. (37 CFR 1.601 (f), 1.601 (n), 1.609(b)(2)).

3. For each party, separately identify the patentable and unpatentable claims which do not correspond to the count (37 CFR 1.609(b)(3)).

4. Forward all files including those the benefit of which is being accorded.

5. Keep a copy of the Interference Initial Memorandum and any attachments for your records.

All information requested below must be attached on (a) separate sheet(s) and type-written.

6. On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.

7. For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention (37 CFR 1.609(b)(2)).

8. For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).

9. For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

| | | | |
|-----------------|--|-------------------------------|------------------|
| DATE 8/11/99 | PRIMARY EXAMINER (Signature) DAVID ISABELLA <i>David Isabella</i> | TELEPHONE NO. 703-308-3060 | ART UNIT 3738 |
| DATE | GROUP DIRECTOR SIGNATURE (if required) <i>[Signature]</i> | | |

**The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

INTERFERENCE INITIAL MEMORANDUM

COUNT 1

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves 2 parties

| PARTY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
|-----------------|-----------------|-------------|--------------------|--------------------|
| MULHAUSER ET AL | 08/250657 | 5/27/94 | | |

If application has been patented, have maintenance fees been paid? 1. ☐ Yes 2. ☐ No 3. ☐ Maintenance fees not yet due

**Accorded the benefit of:

| COUNTRY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
|---------|-----------------|-------------|--------------------|--------------------|
| U.S. | 07/886689 | 5/20/92 | | |
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The claim(s) of this party which correspond(s) to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

~~48, 59-62~~

The claim(s) of this party which does (do) not correspond to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

49-58, 63, 64, 73-76

| PARTY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
|-------------|-----------------|-------------|--------------------|--------------------|
| GREEN ET AL | 07/906588 | 6/30/92 | 5304187 | 4/19/94 |

If application has been patented, have maintenance fees been paid? 4. ☒ Yes 5. ☐ No 6. ☐ Maintenance fees not yet due

**Accorded the benefit of:

| COUNTRY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
|---------|-----------------|-------------|--------------------|--------------------|
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The claim(s) of this party which correspond(s) to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

~~2-38~~

The claim(s) of this party which does (do) not correspond to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

2-38

Instructions

- For every patent involved in the interference, check if the maintenance fees have been paid by using PALM screen 2970 with the patent number. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 U.S.C. 135(a); 37 CFR 1.606).
- For each party, identify the patentable (or patented) and unpatentable (pending) claims which correspond to the count (37 CFR 1.601(f), (n); 1.609(b)(2)).
- For each party, identify the patentable (or patented) and unpatentable (pending) claims which do not correspond to the count (37 CFR 1.609(b)(3)).
- Forward all files including those the benefit of which is being accorded.
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- On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word-for-word as this count, please indicate the party, application or patent number, and the claim number.
- For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention as the count (37 CFR 1.609(b)(2)).
- For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention from the count (37 CFR 1.609(b)(3)).
- For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

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|--------------------------|----------------------------------|-------------------------------|------------------|
| DATE 07 February 2002 | PRIMARY EXAMINER (Signature) | TELEPHONE NO. 703-308-0858 | ART UNIT 3738 |
| DATE | DIRECTOR SIGNATURE (If required) | REVIEWED BY | |

** The application number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

PTO-850 (Rev. 3-98)

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INTERFERENCE INITIAL MEMORANDUM

Count # 2**BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:**This interference involves 2 parties

| | | | | |
|---|-------------------------|------------------------|-------------------------------|-------------------------------|
| PARTY MULHAUSER ET AL | SERIAL NO. 08/250657 | FILING DATE 5/27/94 | PATENT NO., IF ANY | ISSUE DATE, IF ANY 12/1/94 |
| If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> Maintenance fees not due yet | | | | |
| ** Accorded the benefit of: | | | | |
| COUNTRY U.S. | SERIAL NO. 07/886689 | FILING DATE 5/20/92 | PATENT NO., IF ANY | ISSUE DATE, IF ANY 6/11/92 |
| | | | | |
| | | | | |
| The claim(s) of this party which correspond(s) to this count is(are): PATENTABLE CLAIMS UNPATENTABLE CLAIMS 75 (allowable) | | | | |
| The claim(s) of this party which does(do) not correspond to this count is(are): PATENTABLE CLAIMS UNPATENTABLE CLAIMS 48-58,63,64, 73,74,76 | | | | |
| PARTY GREEN ET AL | SERIAL NO. 07/906588 | FILING DATE 6/30/92 | PATENT NO., IF ANY 5304187 | ISSUE DATE, IF ANY 4/19/94 |
| If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>x</u> Maintenance fees not due yet | | | | |
| ** Accorded the benefit of: | | | | |
| COUNTRY | SERIAL NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
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| The claim(s) of this party which correspond(s) to this count is(are): PATENTABLE CLAIMS UNPATENTABLE CLAIMS 36-38 | | | | |
| The claim(s) of this party which does(do) not correspond to this count is(are): PATENTABLE CLAIMS UNPATENTABLE CLAIMS 1-35 | | | | |

Instructions

1. For every patent involved in the interference, check if the fees have been paid by using the **patent number** with the PALM screen CR06.

If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent.
(35 USC 135(a); 37 CFR 1.606).

2. For each party, separately identify the patentable and unpatentable claims which correspond to the count.
(37 CFR 1.601 (f), 1.601 (n), 1.609(b)(2)).

3. For each party, separately identify the patentable and unpatentable claims which do not correspond to the count (37 CFR 1.609(b)(3)).

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7. For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention (37 CFR 1.609(b)(2)).

8. For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).

9. For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

| | | | |
|-----------------|--|-------------------------------|------------------|
| DATE 8/11/99 | PRIMARY EXAMINER (Signature) DAVID ISABELLA <i>David Isabella</i> | TELEPHONE NO. 703-308-3060 | ART UNIT 3738 |
| DATE | GROUP DIRECTOR SIGNATURE (if required) | | |

** The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

INTERFERENCE INITIAL MEMORANDUM

COUNT 2

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves ____ parties

| PARTY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
|-----------------|-----------------|-------------|--------------------|--------------------|
| MULHAUSGE ET AL | 08/20657 | 5/27/94 | | |

If application has been patented, have maintenance fees been paid? 1. ☐ Yes 2. ☐ No 3. ☐ Maintenance fees not yet due

**Accorded the benefit of:

| COUNTRY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
|---------|-----------------|-------------|--------------------|--------------------|
| US | 071886689 | 5/20/92 | | |
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The claim(s) of this party which correspond(s) to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

The claim(s) of this party which does (do) not correspond to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

| PARTY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
|--------------|-----------------|-------------|--------------------|--------------------|
| GEGGEN ET AL | 071906588 | 6/30/92 | 5304187 | 4-19-94 |

If application has been patented, have maintenance fees been paid? 4. ☒ Yes 5. ☐ No 6. ☐ Maintenance fees not yet due

**Accorded the benefit of:

| COUNTRY | APPLICATION NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
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The claim(s) of this party which correspond(s) to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

The claim(s) of this party which does (do) not correspond to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS

UNPATENTABLE PENDING CLAIMS

Instructions

- For every patent involved in the interference, check if the maintenance fees have been paid by using PALM screen 2970 with the patent number. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 U.S.C. 135(a); 37 CFR 1.606).
- For each party, identify the patentable (or patented) and unpatentable (pending) claims which correspond to the count (37 CFR 1.601(f), (n); 1.609(b)(2)).
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- For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention as the count (37 CFR 1.609(b)(2)).
- For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention from the count (37 CFR 1.609(b)(3)).
- For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

| | | | |
|--------------------------|----------------------------------|-------------------------------|------------------|
| DATE 07 February 2002 | PRIMARY EXAMINER (Signature) | TELEPHONE NO. 703-308-0858 | ART UNIT 3738 |
| DATE | DIRECTOR SIGNATURE (If required) | REVIEWED BY | |

** The application number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

PTO-850 (Rev. 3-98)

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INTERFERENCE INITIAL MEMORANDUM

Count # 3

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves 2 parties

| | | | | |
|---|-------------------------|------------------------|--------------------|--------------------|
| PARTY MULHAUSER ET AL | SERIAL NO. 08/250657 | FILING DATE 5/27/94 | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
| If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>Maintenance fees not due yet</u> | | | | |
| **Accorded the benefit of: | | | | |
| COUNTRY | SERIAL NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
| U.S. | 07/886689 | 5/20/92 | | |
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| | | | | |
| The claim(s) of this party which correspond(s) to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 76 (allowable) | | | | |
| The claim(s) of this party which does(do) not correspond to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 48-58,63,64, 73,74,75 | | | | |

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|---|-------------------------|------------------------|-------------------------------|-------------------------------|
| PARTY GREEN ET AL | SERIAL NO. 07/906588 | FILING DATE 6/30/92 | PATENT NO., IF ANY 5304187 | ISSUE DATE, IF ANY 4/19/94 |
| If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>x</u> Maintenance fees not due yet | | | | |
| **Accorded the benefit of: | | | | |
| COUNTRY | SERIAL NO. | FILING DATE | PATENT NO., IF ANY | ISSUE DATE, IF ANY |
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| The claim(s) of this party which correspond(s) to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 25-30 | | | | |
| The claim(s) of this party which does(do) not correspond to this count is(are): | | | | |
| PATENTABLE CLAIMS | | UNPATENTABLE CLAIMS | | |
| 1-24,31-38 | | | | |

Instructions

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(35 USC 135(a); 37 CFR 1.606).

2. For each party, separately identify the patentable and unpatentable claims which correspond to the count.

(37 CFR 1.601 (f), 1.601 (n), 1.609(b)(2)).

3. For each party, separately identify the patentable and unpatentable claims which do not correspond to the count (37 CFR 1.609(b)(3)).

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8. For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).

9. For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

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|-----------------|--|-------------------------------|------------------|
| DATE 8/11/99 | PRIMARY EXAMINER (Signature) DAVID ISABELLA <i>David Isabella</i> | TELEPHONE NO. 703-308-3060 | ART UNIT 3738 |
| DATE | GROUP DIRECTOR SIGNATURE (if required) | | |

**The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

Art Unit: 3738

INTERFERENCE INITIAL MEMORANDUM

Application v Patent: Application SN 08/250,657 (Mulhauser, et al)

Patent No. 5,304,187 (Green, et al)

Patent No. 5,304,187 (Green, et al)

The patent to Green, et al contains 38 patented claims.

Claims 1,4,10,19,22,25,27,31,32 and 36 are independent claims.

Application SN 08/250,657 (Mulhauser, et al)

The application was filed with 72 claims. Restriction was applied to the claims and applicant elected claims 48-64 for prosecution. Claims 1-47 and 65-72 have been canceled. New claims 73-76 were added by amendment and these claims were included with elected claims 48-64 for prosecution.

Art Unit: 3738

Counts:

Count 1: Claims 48,59-62 of Mulhauser, et al and claim 1 of Green, et al correspond to count 1.

Count 2: Claim 75 of Mulhauser, et al and claims 36-38 of Green, et al correspond to count 2.

Count 3: Claim 76 of Mulhauser, et al and claims 25-30 of Green, et al correspond to count 3.

Art Unit: 3738

Count 1:

An apparatus for delivering surgical implant comprising;
an elongated body having a lumen extending therethrough and an elongated slot extending radially from said lumen through a surface of said elongated body,
said elongated slot adapted for receipt of a surgical implant in a first expanded configuration; and
said elongated body lumen adapted to receive and maintain a surgical implant in a second rolled configuration; and
means positioned within said elongated body lumen for deploying surgical implant from a distal end of said elongated body lumen.

Art Unit: 3738

Claims corresponding to Count 1:

1) Green, et al, US Patent No. 5,304,187

Claim 1 corresponds to Count 1. Claim 1 sets forth an apparatus for deploying a rolled surgical element including a housing means (elongated body), longitudinal slot (elongated slot), the slot receives the surgical element in an expanded configuration and the surgical element is then rolled into a second rolled configuration (rolled configuration) and means (means partially positioned within said elongated body lumen) for deploying the implant from the body lumen.

2) Mulhauser, et al, Application SN 08/250,657

Independent claim 48 corresponds to Count 1. Claim 48 sets forth an apparatus for delivering a prosthesis, the apparatus having an elongated body, an elongated slot. The slot receives the prosthesis in a first configuration (an expanded configuration) and the elongated body is adapted to maintain the prosthesis in the second configuration (the surgical element is then rolled into a second rolled configuration).

Dependent claim 59 corresponds to Count 1. The claim set forth means for advancing the prosthesis in the second configuration through the elongated body lumen (means at least partially positioned within said elongated body lumen for ejecting the surgical implant from a distal end of said elongated body lumen).

Dependent claim 60 corresponds to Count 1. The means for advancing the implant in Mulhauser, et al is a shaft (206) rotatably moveable within the elongated body lumen.

Art Unit: 3738

Dependent claim 61 corresponds to Count 1. The claim further defines the shaft as having an opening (213) to receive the prosthesis.

Dependent claim 62 corresponds to Count 1. The claim defines the prosthesis as being releasably threaded to the shaft.

Claims that don't correspond to Count 1

1) Green, et al, US Patent No. 5,304,187

Dependent claims 2 and 3, independent claim 4, 10, 19 and 22 don't correspond to Count 1. Claims 2, 3, 4, 10, 19, and 22 further define manipulating means adjacent to the distal end of the housing. The manipulating means is a pair of jaws.

Dependent claims 5-9 depend from independent claim 4.

Dependent claims 11-18 depend from independent claim 10.

Dependent claims 20 and 21 depend from independent claim 19.

Dependent claims 23 and 24 depend from independent claim 22.

Independent claim 25 and dependent claim 26 don't correspond to Count 1. These claims are directed to a method for positioning a rolled surgical element adjacent to body tissue.

Independent claim 27 and dependent claims 28-30 don't correspond to Count 1. These claims are directed to a method for positioning a rolled surgical element adjacent to body tissue.

Independent claim 31 does not correspond to Count 1. This claim is directed to a method

Art Unit: 3738

for positioning a rolled surgical element adjacent to body tissue. The claim also requires the extra step of manipulating the implant with the jaw means.

Independent claim 32 and dependent claims 33-35 don't correspond to Count 1.

Independent claim 32 is directed to a deploying apparatus comprising an additional pusher member concentrically positioned between the outer tube and the inner rod. The pusher member is adapted to eject the surgical element from the distal end of the outer tube.

Claim 33, depends from independent claim 32, does not correspond to Count 1. This claim further defines a pair of jaws.

Claim 34 depends from independent claim 32. The claim defines a slot in the inner rod.

Claim 35 depends from claim 34 which depends from independent claim 32. The claim further defines the slot.

Independent claim 36 and dependent claims 37-38 don't correspond to Count 1. These claims are directed to a surgical kit including the combination of the surgical implant and the deploying apparatus.

Dependent claims 37 and 38 further define the surgical implant.

2) Mulhauser, et al, Application SN 08/250,657

Dependent claims 49-58 don't correspond to Count 1. These claims are directed to an additional featured element, a cartridge for holding the surgical implant in the first configuration.

Art Unit: 3738

Dependent claims 63 does not correspond to Count 1. This claim is directed to an additional featured element, means for arresting axial movement of the shaft during a predetermined number of rotation of the shaft.

Dependent claims 64 does not correspond to Count 1. This claim is directed to an additional featured element, the shaft includes an externally threaded portion which mates with an internally threaded portion of the main body.

Dependent claims 73 and 74 do not correspond to Count 1. These claims are directed to the distal end of the delivery apparatus including a portion which is constructed for mounting to a trocar.

Independent claim 75 does not correspond to Count 1. This claim is directed to a surgical kit including the combination of the surgical implant and the deploying apparatus.

Independent claim 76 does not correspond to Count 1. This claim is directed to a method for positioning a rolled surgical element adjacent to body tissue by positioning the distal end of the elongated body in the lumen of the trocar and advancing the prosthesis into the trocar cannula lumen.

Art Unit: 3738

Count 2:

A kit for delivering surgical implant comprising;

a surgical implant; and

an apparatus having an elongated body having a lumen extending therethrough and an elongated slot extending radially from said lumen through a surface of said elongated body, said elongated slot adapted for receipt of said surgical implant in a first expanded configuration,

said elongated body lumen adapted to receive and maintain said surgical implant in a second rolled configuration; and

means positioned within said elongated body lumen for deploying said rolled surgical implant from said elongated body lumen.

Art Unit: 3738

Claims corresponding to Count 2:

1) Green, et al, US Patent No. 5,304,187

Claims 36-38 corresponds to Count 2. Independent claim 36 sets forth a surgical kit for deploying a rolled surgical element including a surgical implant and a deploying apparatus. The apparatus having a housing means (elongated body), longitudinal slot (elongated slot), the slot receives the surgical element in an expanded configuration and the surgical element is then rolled into a second rolled configuration (rolled configuration) and means (means partially positioned within said elongated body lumen) for deploying the implant from the body lumen.

Dependent claims 37 and 38 further define the surgical implant.

2) Mulhauser, et al, Application SN 08/250,657

Independent claim 75 corresponds to Count 2. Claim 75 sets forth a combination including a prosthesis and an apparatus for delivering a prosthesis. The apparatus having an elongated body, an elongated slot. The slot receives the prosthesis in a first configuration (an expanded configuration) and the elongated body is adapted to maintain the prosthesis in the second configuration (the surgical element is then rolled into a second rolled configuration) and means for deploying the prosthesis from the elongated body..

Art Unit: 3738

Claims that don't correspond to Count 2:

1) Green, et al, US Patent No. 5,304,187

Independent claim 1 does not correspond to Count 2. Independent claim 1 is directed solely to the deploying apparatus and does not include the surgical element which is to be deployed.

Dependent claims 2 and 3, independent claim 4, 10, 19 and 22 don't correspond to Count 2. Claims 2, 3, 4, 10, 19, and 22 further define manipulating means adjacent to the distal end of the housing. The manipulating means is a pair of jaws.

Dependent claims 5-9 depend from independent claim 4.

Dependent claims 11-18 depend from independent claim 10.

Dependent claims 20 and 21 depend from independent claim 19.

Dependent claims 23 and 24 depend from independent claim 22.

Independent claim 25 and dependent claim 26 don't correspond to Count 2. These claims are directed to a method for positioning a rolled surgical element adjacent to body tissue.

Independent claim 27 and dependent claims 28-30 don't correspond to Count 2. These claims are directed to a method for positioning a rolled surgical element adjacent to body tissue.

Independent claim 31 does not correspond to Count 2. This claim is directed to a method for positioning a rolled surgical element adjacent to body tissue. The claim also requires the extra step of manipulating the implant with the jaw means.

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Independent claim 32 and dependent claims 33-35 don't correspond to Count 2.

Independent claim 32 is directed to a deploying apparatus comprising an additional pusher member concentrically positioned between the outer tube and the inner rod. The pusher member is adapted to eject the surgical element from the distal end of the outer tube.

Claim 33, depends from independent claim 32, does not correspond to Count 2. This claim further defines a pair of jaws.

Claim 34 depends from independent claim 32. The claim defines a slot in the inner rod.

Claim 35 depends from claim 34 which depends from independent claim 32. The claim further defines the slot.

2) Mulhauser, et al, Application SN 08/250,657

Independent claim 48 does not correspond to Count 2. Independent claim 48 is directed solely to the deploying apparatus and does not include the surgical element which is to be deployed.

Dependent claims 49-58 don't correspond to Count 2. These claims are directed to an additional featured element, a cartridge for holding the surgical implant in the first configuration.

Dependent claim 59 corresponds to Count 2. The claim set forth means for advancing the prosthesis in the second configuration through the elongated body lumen (means at least partially positioned within said elongated body lumen for ejecting the surgical implant from a distal end of said elongated body lumen).

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Dependent claim 60 corresponds to Count 2. The means for advancing the implant in Mulhauser, et al is a shaft (206) rotatably moveable within the elongated body lumen.

Dependent claim 61 corresponds to Count 2. The claim further defines the shaft as having an opening (213) to receive the prosthesis.

Dependent claim 62 corresponds to Count 2. The claim defines the prosthesis as being releasably threaded to the shaft.

Dependent claims 63 does not correspond to Count 2. This claim is directed to an additional featured element, means for arresting axial movement of the shaft during a predetermined number of rotation of the shaft.

Dependent claims 64 does not correspond to Count 2. This claim is directed to an additional featured element, the shaft includes an externally threaded portion which mates with an internally threaded portion of the main body.

Dependent claims 73 and 74 do not correspond to Count 2. These claims are directed to the distal end of the delivery apparatus including a portion which is constructed for mounting to a trocar.

Independent claim 76 does not correspond to Count 2. This claim is directed to a method for positioning a rolled surgical element adjacent to body tissue by positioning the distal end of the elongated body in the lumen of the trocar and advancing the prosthesis into the trocar cannula lumen.

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Count 3:

A method for delivering a surgical implant adjacent to body tissue, comprising:

providing a surgical element and an apparatus having an elongated body having a lumen extending therethrough and an elongated slot extending radially from said lumen through a surface of said elongated body, and means positioned within said elongated body lumen for deploying said surgical element from said elongated body lumen,:

inserting said surgical element in a first expanded configuration into said elongated slot and rolling said surgical element to a second rolled configuration to be received and maintained within said elongated body lumen;

positioning said means in close proximity to a predetermined site in the body tissue and deploying said rolled surgical element to said predetermined site.

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Claims corresponding to Count 3:

1) Green, et al, US Patent No. 5,304,187

Claims ~~25-30~~ correspond to Count 3. Independent claims 25 and 27 are directed to a method for positioning a rolled surgical element adjacent to body tissue. The method includes the steps of deploying a rolled surgical element from an apparatus having a tubular sleeve, a longitudinal slot wherein the slot receives the surgical element in an expanded configuration and the surgical element is then rolled into a second rolled configuration. Steps for positioning the surgical element in close proximity of the tissue and for deploying the implant from the tubular sleeve are included.

Dependent claim 26 defines the surgical element as a mesh implant.

Dependent claim 28 defines a step for manipulating the surgical element adjacent the body tissue.

Claims 29 and 30 defines the surgical element as a mesh implant.

2) Mulhauser, et al, Application SN 08/250,657

Independent claim 76 corresponds to Count 3. This claim is directed to a method for positioning a rolled surgical element adjacent to body tissue by positioning the distal end of the elongated body in the lumen of the trocar and advancing the prosthesis into the trocar cannula lumen.

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Claims that don't correspond to Count 3:

1) Green, et al, US Patent No. 5,304,187

Independent claim 1 does not correspond to Count 3. Independent claim 1 is directed solely to the deploying apparatus and does not include the surgical element which is to be deployed.

Dependent claims 2 and 3, independent claim 4,10,19 and 22 don't correspond to Count 3. Claims 2,3,4,10,19, and 22 further define manipulating means adjacent to the distal end of the housing. The manipulating means is a pair of jaws.

Dependent claims 5-9 depend from independent claim 4.

Dependent claims 11-18 depend from independent claim 10.

Dependent claims 20 and 21 depend from independent claim 19.

Dependent claims 23 and 24 depend from independent claim 22.

Independent claim 31 does not correspond to Count 3. This claim is directed to a method for positioning a rolled surgical element adjacent to body tissue. The claim also requires the extra step of manipulating the implant with the jaw means.

Independent claim 32 and dependent claims 33-35 don't correspond to Count 3.

Independent claim 32 is directed to a deploying apparatus comprising an additional pusher member concentrically positioned between the outer tube and the inner rod. The pusher member is adapted to eject the surgical element from the distal end of the outer tube.

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Claim 33, depends from independent claim 32, does not correspond to Count 3. This claim further defines a pair of jaws.

Claim 34 depends from independent claim 32. The claim defines a slot in the inner rod.

Claim 35 depends from claim 34 which depends from independent claim 32. The claim further defines the slot.

2) Mulhauser, et al, Application SN 08/250,657

Independent claim 48 does not correspond to Count 3. Independent claim 48 is directed solely to the deploying apparatus and does not include the surgical element which is to be deployed.

Dependent claims 49-58 don't correspond to Count 3. These claims are directed to an additional featured element, a cartridge for holding the surgical implant in the first configuration.

Dependent claim 59 corresponds to Count 3. The claim set forth means for advancing the prosthesis in the second configuration through the elongated body lumen (means at least partially positioned within said elongated body lumen for ejecting the surgical implant from a distal end of said elongated body lumen).

Dependent claim 60 corresponds to Count 3. The means for advancing the implant in Mulhauser, et al is a shaft (206) rotatably moveable within the elongated body lumen.

Dependent claim 61 corresponds to Count 3. The claim further defines the shaft as having an opening (213) to receive the prosthesis.

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Dependent claim 62 corresponds to Count 3. The claim defines the prosthesis as being releasably threaded to the shaft.

Dependent claims 63 does not correspond to Count 3. This claim is directed to an additional featured element, means for arresting axial movement of the shaft during a predetermined number of rotation of the shaft.

Dependent claims 64 does not correspond to Count 3. This claim is directed to an additional featured element, the shaft includes an externally threaded portion which mates with an internally threaded portion of the main body.

Dependent claims 73 and 74 do not correspond to Count 3. These claims are directed to the distal end of the delivery apparatus including a portion which is constructed for mounting to a trocar.

DAVID J. ISABELLA

PRIMARY EXAMINER

ART UNIT 3738

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